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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,916	03/03/2004	Hugh R. Sharkey	33108-703.201	3842

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EXAMINER

STEWART, ALVIN J

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 09/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/791,916

Applicant(s)

SHARKEY ET AL.

Examiner

Alvin J. Stewart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 11-26, 32-38, 40, 46-51, 53, 54, 60-67 and 70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 11-26, 32-38, 40, 46-51, 53, 54, 60-67 and 70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 06/27/06; 03/27/06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 06/22/06 have been fully considered but they are not persuasive.

The Examiner understands why the Applicant's representative believes that the claims don't read on the Mazzocchi reference. However, the claims read on the reference because the Examiner interpreted the word inflatable as something that expand or increase abnormally as disclosed in the M-W dictionary. The Examiner doesn't have to look for something that is expanded by a fluid.

Regarding the Van Tassel et al reference, the Examiner believes that the reference still read on the rejected claims. For example, the Examiner is giving patentable weight to the structure limitations on the claims and is not giving patentable weight to the functional language disclosed in the claims, such as the words "configured to", "for increasing...", etc.. for this type of wording the examiner has considered those words but the Examiner has not giving patentable weight to it.

The Examiner has to find for a structure limitation having an inflatable element (see element 402, in Fig. 14), an interior (interior of balloon), a peripheral edge (outer contour of balloon) and a distal support element (see element 40). The rest of the phrases in the claim 21, has been considered but has not been given patentable weight because they are functional language. The structure is capable of dividing two sections in a productive section and a non-productive section, as shown in Figs. 17 & 18.

Finally, the word “partitioning” has not been given patentable weight and is only part of the structure name.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7, 11-15, 33-36, 38, 40, 46, 53, 54 and 67 are rejected under 35 U.S.C. 102(b) as being anticipated by Mazzocchi US Patent 6,506,204 B2.

Mazzocchi discloses an implant comprising an inflatable partitioning element (60) having an outer periphery with a proximal face (70), at least one anchoring element (72), a distal face (82) and a hub (15).

Regarding the functional language disclosed in most of the claims, in order to be given patentable weight, a functional recitation must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172; 388 O.G. 279.

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA1959). “Apparatus claims cover what a device *is*, not what a device *does*.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525,

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1528 (Fed. Cir. 1990).

In claims 1, 21, line 2, it has been held that the recitation that an element is “configured to” performing a function is not a positive limitation but only requires the ability to so perform.

Regarding the word “inflatable”, the Examiner has interpreted the word “inflatable” as something that expands or increases abnormally. Not necessarily has to be expanded by fluid.

Claims 1-3, 5-7, 15-26, 32, 53, 54, 60 and 61 are rejected under 35 U.S.C. 102(e) as being anticipated by Van Tassel et al US Patent 6,652,555 B1.

Van Tassel et al discloses an inflatable partitioning element (see the whole device in Fig. 14) having an interior configured to receive inflation fluid, a distally extending supporting element (402), a hub (408) and a valve (426).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mazzocchi in view of Lichtenstein US Patent Pub. 2005/0015109.

Mazzocchi discloses the invention substantially as claimed. However, Mazzocchi does not disclose hooks.

Lichtenstein discloses an implant comprising a plurality of hooks capable of securing the implant to part of the human body (see paragraph 38).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the surface of the proximal end of the Mazzocchi reference by adding hooks around the surface in order to secure the implant into parts of the human body.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin J. Stewart whose telephone number is 571-272-4760. The examiner can normally be reached on Monday-Friday 7:00AM-5:30PM(1 Friday B-week off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



ALVIN J. STEWART
PRIMARY EXAMINER

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September 5, 2006.